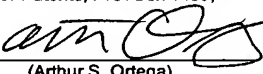


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Dated: September 25, 2006 Signature: 

(Arthur S. Ortega)

Docket No.: LOREAL 3.0-058
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Philippe Briand

Application No.: 10/645,771

Group Art Unit: 3754

Filed: August 21, 2003

Examiner: J. A. Kaufman

For: DISPENSER DEVICE

APPELLANT'S REPLY BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant hereby files this Reply Brief in response to the Examiner's Answer dated July 24, 2006, pursuant to 37 C.F.R. § 41.41.

Appellant submits this Reply Brief to address several issues presented by the Examiner's Answer. Despite the Examiner's allegations to the contrary: (a) there is clear written description support for the subject matter in claims 20, 22, 24, and 26; (b) claims 1, 2, 4-11, 13, 14, and 16-27 are not anticipated by Stull; and (c) claims 3, 12, and 15 are not obvious over Stull. These issues will be addressed below.

Appellant acknowledges that in the Examiner's Answer, the Examiner has found Appellant's remarks concerning the dispenser surface receiving flow from the orifice persuasive and has withdrawn the rejection of claims 21, 23, 25, and 27 under 35 U.S.C. § 112, first paragraph.

**A. There Is Clear Written Description Support For
The Subject Matter In Claims 20, 22, 24, And 26**

In the Examiner's Answer, regarding claims 20, 22, 24, and 26, the Examiner found Appellant's remarks concerning the orifice being in a "fixed position" independent of the second part unpersuasive "because the passages cited in the arguments do not support such a feature. There is no mention of such a relationship, nor can one be reasonably inferred." (Examiner's Answer section 10.)

Appellant respectfully disagrees. According to the M.P.E.P.:

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.

M.P.E.P. § 2163.02 (8th ed. Rev. 3) (emphasis in original).

Moreover, as the Federal Circuit has stated:

Ipsis verbis disclosure is not necessary to satisfy the written description requirement of section 112. Instead, the disclosure need only convey to persons skilled in the art that the inventor had possession of the subject matter in question.

Fujikawa v. Wattanasin, 93 F.3d 1559, 39 U.S.P.Q.2d 1895 (Fed. Cir. 1996) (emphasis in original).

Thus, the subject matter of the feature "fixed position" does not have to be described literally to satisfy the description requirement. That said, the specification as filed more than adequately provides written description support for the term "fixed position."

An orifice being in a "fixed position" independent of the second part means an orifice being in a constant or permanent position independent of the second part. As the specification explains, the dispenser orifice is described in paragraph [0023]:

The dispenser orifice may be permanently formed between the surfaces belonging respectively to the first and second parts, regardless of whether the dispenser device is in the dispensing position or the closed position.

(Specification ¶ [0023] (emphasis added).)

The dispenser orifice 90 is shown in Fig. 6 and its position is described in paragraph [0054] as being "substantially constant":

In the example described, the spacing between the facing surfaces 60 and 80 is of a size j that is substantially constant regardless of whether or not substance is being dispensed

(Id. ¶ [0054].)

It is this "spacing between the facing surfaces" which defines orifice 90.

It may be instructive to explain the operation of the device to illustrate that the dispenser orifice 90 has a constant spacing or gap formed between surfaces of the first and second parts 30, 40 regardless of whether a substance is being dispensed. Fig. 6 shows dispenser orifice 90 having a gap or spacing j between the facing surfaces 60 and 80 of a size j where surface 60 is on the first part 30 and the surface 80 is on the second part. It is this gap that is constant regardless of the position of the dispenser. The dispenser device in the closed or non-dispensing position is shown in Fig. 4. In this position, Fig. 6 shows the spacing of dispenser orifice 90. As explained in paragraph [0021], the second part 40 may be turned relative to the first part 30 to switch from the closed position to the dispensing position, as shown in Fig. 5. In this position, Fig. 6 also shows the spacing of dispenser orifice 90. While part 40 may rotate around part 30, the gap 90 does not change in location, orientation, or in dimension. In other words, although the dispenser device may be dispensing or not, the gap forming the

dispenser orifice 90 is the same. Therefore, there is clear written description support for the feature of a "fixed position" for the dispenser orifice independent of the second part, as recited in claims 20, 22, 24, and 26.

Accordingly, with written description support for both of the foregoing features, claims 20, 22, 24, and 26 clearly do not include any new matter, and the rejection of claims 20, 22, 24, and 26 under 35 U.S.C. § 112, first paragraph, should be withdrawn.

**B. Claims 1, 2, 4-11, 13, 14, And
16-27 Are Not Anticipated By Stull**

In the Official Action of June 13, 2005, claims 1, 2, 4-11, 13, 14, and 16-27 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,358,146 (Stull).

Appellant respectfully asserts, that for at least the following reasons, claims 1, 2, 4-11, 13, 14, and 16-27 are not anticipated by Stull. First, the Examiner's reference to a dictionary meaning of an "orifice" supports Appellant. Second, Stull does not disclose an orifice disposed between and defined by two parts, or surfaces of two different parts of a receptacle or device as in the present invention. Third, even if one were to consider the Examiner's definition of an "orifice," any purported orifice in Stull still does not open directly to the environment as in the present invention.

**1. Examiner's Dictionary Definition
Of "Orifice" Supports Appellant**

In the Examiner's Answer, the Examiner rejected the Appellant's remarks and stated:

Appellant further contends that Stull does not disclose the orifice as claimed in the invention. An orifice is defined in *Webster's New World Dictionary, Third College Edition*, as a "mouth, an aperture of a tube, cavity,

etc.; opening". As discussed above, the orifice of Stull is discussed as the opening 30, 36 between the parts 22 and 24 (when they are aligned for dispensing). As this opening clearly meets the definition of an orifice, the claimed invention is met. Appellant has not defined an orifice anywhere in the specification to only mean the exact exit point of the material as appellant appears to be arguing. Therefore, the orifice can have its ordinary meaning that is clearly supported by the dictionary definition.

(Examiner's Answer Section 10 (emphasis in original).)

For at least the following reasons Appellant respectfully disagrees.

As argued by the Examiner, the definition of the term "orifice" refers to a "mouth, an aperture of a tube . . . opening." To one of ordinary skill in the art, such a definition means an entry (or exit) point of a tube but not the tube itself.

In the present invention, referring to Figs. 1 and 4-5 of the specification, dispenser 90 is formed at the top of the device as a gap 90 between end wall 37 of the first part 30 and top wall 42 of the second part 40. Thus, the orifice of the present invention is a mouth of a tube which is consistent with the dictionary meaning presented by the Examiner.

In contrast, in Stull, the Examiner argues that combined passages 30 and 36, which clearly form a tube, are not an orifice. But this is contrary to the very definition cited by the Examiner. Indeed, if anything in Stull is to be construed as an "orifice" it would be 38 which even Stull recognizes as a discharge "orifice." Not surprisingly, Stull did not define the conduit formed by 30 and 36 as an "orifice" as it clearly is not. Thus, for at least these reasons, one of ordinary skill in the art would find the orifice of the present invention consistent with the dictionary meaning of orifice whereas passages 30, 36 of Stull are not.

This is significant because the claimed invention requires an orifice defined by two structural parts of the container, which is in a fixed position, and which opens directly to the environment. Stull meets none of these recitations.

**2. Stull Does Not Disclose A Dispenser
Orifice Of The Present Invention**

Referring to Figs. 1 and 4-5 of the specification, shown is a dispenser device 20 comprising two parts 30, 40. The top wall 42 of the second part 40 has an opening into which the end wall 37 of the first part 30 extends. At the top of the device, a gap is formed between the two parts 30, 40 to form the dispenser orifice 90. Thus, the end wall 37 of part 30 together with the top wall 42 of the second part 40 form dispenser orifice 90 as an exit point where a substance in the receptacle exits the device directly to the environment. Thus, in light of the specification and drawings, an exit point where a substance exits the dispenser device is clearly defined.

In contrast, orifice 80 of Stull (the only structure in Stull that both meets the Examiner's cited definition and identified in Stull as an orifice) is not formed between two parts or the surfaces of the two different parts as in the present invention. The Examiner obviously appreciated this deficiency of Stull and therefore sought to broaden the definition of orifice. As explained above, in the Examiner's Answer, the Examiner argued that passages 30, 36 of Stull, not discharge orifice 80, was the "orifice." However, such a conclusion is erroneous. As explained above, both the orifice of the present invention and discharge orifice 80 of Stull meet the Examiner's dictionary definition of the term "orifice" whereas passages 30, 36 of Stull clearly do not. Passages 30, 36 do not form a dispenser orifice. Instead, as

described in Stull at column 3, lines 46 to 54, they are a part of an internal valving means that is in communication between discharge orifice 38 and the interior of the container. Indeed, the mere fact that Stull actually calls another part an orifice (i.e., the discharge orifice 38), instead of combined passages 30 and 36, supports the notion that the combined passages are not, in fact, an orifice, or at least not one that one of ordinary skill in the art would consider an orifice.

In summary, while Stull describes a structure which is defined by two separate parts of the container, that structure cannot be reasonably considered an "orifice." Such an interpretation is contrary to not only the plain meaning of the term as used in the application and the Stull reference, but also to the very definition provided by the Examiner in his Examiner's Answer. Stull does not define an orifice defined by two structural components as claimed.

Moreover, if one were to conclude that the conduit formed by elements 30, 36 of Stull were an orifice, it would not be an orifice having a fixed position as these structures can be moved relative to one another. (See Stull col.6, 11.31-35.) The feature of "fixed position" of the present invention is recited in claims 20, 22, 24, and 26 as explained above.

Thus, for the reasons provided above and in the Supplemental Appeal Brief, Stull fails to disclose a dispenser orifice as defined in the present invention.

**3. Even If Considered An Orifice As
Defined, Stull's Passages Nonetheless
Do Not Open "Directly" To The Environment**

In the Examiner's Answer, the Examiner rejected the Appellant's remarks.

Appellant respectfully asserts that the orifice of the present invention opens "directly" to the environment and that Stull fails to disclose such a feature.

The Federal Circuit has recently reinforced that the claims themselves, the specification, and the prosecution history are the principal sources for determining the meaning of particular claim terms. *Philips v. AWH Corp.*, 415 F.3d 1303, 1317-18 (Fed. Cir. 2005) (en banc). "Extrinsic" evidence, such as dictionaries, treatises, inventor and expert testimony may also be used to help educate a court to determine the proper claim construction, but it is deemed inherently less reliable than the "intrinsic" evidence of the claims, specification and prosecution history. *Id.* The focus is to determine the meaning of the claim term to a person of ordinary skill in the art as of the effective filing date of the patent. *Id.*

As shown in Figs. 1 and 4-6 of the present specification, the dispenser orifice 90 is formed at the top of the device. As explained in paragraph [0053]:

The surface 80 cooperates with facing surface 60 of the wall to define a dispenser orifice 90 through which the substance can leave the dispenser device.

Thus, as is apparent from the specification and drawings, the dispenser orifice 90 opens out directly to the environment without anything intervening between the dispenser orifice 90 and the environment.

In contrast, if the orifice of Stull is defined by passages 30 and 36, then Stull does not disclose a dispenser orifice that opens out directly to the environment as in the present invention. In Stull, the passages 30 and 36 do not open out directly to the outside or environment. The contents of Stull's dispenser must pass through passage 36 first, then

through passage 30, and finally through the discharge orifice 38. In other words, the discharge orifice 38 is intervening between the passages 30, 36 and the environment. Thus, the contents of the dispenser must pass through the discharge orifice 38 in order to be discharged or to reach the environment.

Therefore, for the above reasons as well as the reasons in the Supplemental Appeal Brief, claims 1, 2, 4-11, 13, 14, and 16-27 are not anticipated by Stull.

C. Claims 3, 12, And 15 Are Not Obvious Over Stull

Appellant wishes to remind the Examiner that because a reference can or could be modified does not make such modification sufficient to conclude obviousness. As the Federal Circuit stated:

The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.

In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989) (emphasis added).

Thus, the fact that references can or could be combined or modified is not sufficient to establish obviousness. Such requirements are consistent with the M.P.E.P:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.

M.P.E.P. § 2143.01 III (8th ed. Rev. 3) (emphasis in original).

Hindsight reconstruction is not permitted. Case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of

the teaching or motivation. See *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

In the Examiner's Answer, the Examiner rejected the Appellant's remarks.

Appellant respectfully asserts that claims 3, 12, and 15 are not obvious over Stull for at least the following reasons.

Turning to the Examiner's Answer, the Examiner stated that sources for motivation may be implicit, well-known as well as for reasons different than from those of the present invention. (See Examiner's Answer Section 10.) Although motivation may be derived from different sources, it is not sufficient to assert that Stull could be modified to arrive at the claimed invention. What is missing from the record is sufficient evidence of why Stull should, not just simply could, be modified to arrive at the claimed invention. Thus, Appellant believes that the Examiner has not met the standard for obviousness.

Rather than finding the motivation to combine/modify the references in the prior art, the rejection is a classic example of hindsight reconstruction in which features are selected from different prior art references to create the subject matter claimed in claims 3, 12, and 15. However, the law is clear. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).


Therefore, for at least the reasons set forth above and in the Supplemental Appeal Brief, claims 3, 12, and 15 are not obvious over Stull.

CONCLUSION

For the reasons set forth above, the Examiner's rejection of claims 20, 22, 24, and 26 under 35 U.S.C. § 112, first paragraph, claims 1, 2, 4-11, 13, 14, and 16-27 under 35 U.S.C. § 102(b), and claims 3, 12, and 15 under 35 U.S.C. § 103(a) must be withdrawn and the claims allowed.¹

Respectfully submitted,

Dated: September 25, 2006

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¹ Applicant notes that claim 19 remains rejected under 35 U.S.C. § 112, second paragraph, but may be easily attended to with a simple amendment to replace the phrase "dispenser opening" with the phrase "dispenser orifice" in the claim.